

APPLICANT(S): A. RIBAK, et al.  
SERIAL NO.: 10/695,972  
FILED: October 29, 2003  
Page 4

### **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### **Status of Claims**

Claims 15 - 25 and 37 are pending in the application and have been rejected. There are no amendments presented herewith.

### **The Telephone Interview**

Initially, Applicants wish to thank the Examiner, Michael Yaary, for granting and attending the brief telephone interview with Applicants' Representative, Heidi M. Brun, Reg. No. 34,504 on Feb 12, 2009. During the Interview, the Advisory Action of January 21, 2009 was discussed.

### **CLAIM REJECTIONS**

#### **35 U.S.C. § 103 Rejections**

In the Office Action the Examiner rejected claims 15 and 37 under 35 U.S.C. 103(a) as being anticipated by Ruths et al. (*US Patent Publication No. 2003/0018719*) in view of Guthrie (*US Patent Publication 2004/015811*) and rejected claims 16 – 25 under 35 U.S.C. 103(a) as being anticipated by Ruths et al. and Guthrie in view of Fitzpatrick (*US Patent 7,039,677*). Applicants respectfully traverse this rejection in view of the remarks that follow.

Applicants respectfully submit that Guthrie is not prior art and, therefore, cannot be the basis of any prior art rejection. The effective filing date of Guthrie is February 10, 2003, whereas the filing date herein is October 29, 2003. Since Guthrie is not more than a year prior to the filing date, it is not prior art.

APPLICANT(S): A. RIBAK, et al.  
SERIAL NO.: 10/695,972  
FILED: October 29, 2003  
Page 5

Moreover, the date of Invention of the subject matter of this application is no later than 2001 and reference is made to the accompanying Declaration of the Inventor Amnon Ribak. The formal disclosure was submitted to the IBM IP Department in October, 2001. Thus, Guthrie is likewise not prior to the date of Invention and is not prior art on this basis.

In the Advisory Action, the Examiner stated that "Applicant has provided insufficient amount of evidence with the affidavit to show that due diligence or reduction to practice was established."

Applicants respectfully disagree. The original January 5, 2009 Declaration of the Inventor A. Ribak said that the invention was made in 2001 and that the formal disclosure was submitted to the IBM IP Department in October 3001. This necessarily meant the invention was reduced to practice, or a formal disclosure could not have been made. The Declaration has been re-executed to more specifically state that there was reduction to practice.

However, by the plain wording of 37 C.F.R. 1.131(b), diligence need not be shown if the invention was reduced to practice.

"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference ..."

Diligence need only be shown when there was no reduction of practice –

"The showing of facts shall be such, in character and weight, as to establish ... conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application."

Since there was reduction to practice, as evidenced by the Internal IBM Document IL9-2002-0009, and this was before the date of the reference, diligence need not be established.

Further, in M.P.E.P. ¶ 715, form paragraphs are listed to guide the Examiner in how to respond to a 37 CFR 1.131 affidavit. As per suggested ¶ 7.59, if the Examiner believes that the evidence is "insufficient to establish a reduction to practice of the invention," then "an explanation of the lack of showing of the alleged reduction to practice must be provided." In view of the attached Internal IBM Document, reduction to practice was obvious. The

APPLICANT(S): A. RIBAK, et al.  
SERIAL NO.: 10/695,972  
FILED: October 29, 2003  
Page 6

Examiner provided no reasons for rejecting the claim of reduction to practice. Similarly, as per suggested ¶ 7.62, if the Examiner believes diligence is lacking, then an “explanation of the reasons for a holding of non-diligence must be provided.” No such reasons were provided by the Examiner.

Therefore, it is respectfully requested that the rejections under Section 103 be withdrawn. Since Guthrie is a critical reference in the prior art rejections, the rejections cannot be supported without it and obviously must be withdrawn.

In view of the foregoing remarks, the pending claims 15 – 25 and 37 are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Response, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this response to Deposit Account 09-0468.

Respectfully submitted,

By: /Suzanne Erez/  
Suzanne Erez  
Reg. No. 46,688  
Phone No. 1-888-260-5928

Date: 4 March 2009  
IBM Corporation  
Intellectual Property Law Dept.  
P. O. Box 218  
Yorktown Heights, New York 10598